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| APPLICATION NO.              | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------|-------------|------------------------|---------------------|------------------|
| 10/690,203                   | 10/20/2003  | Kenneth E. Kadziauskas | 3109                | 3684             |
| 26822                        | 7590        | 11/14/2007             | EXAMINER            |                  |
| WALTER A. HACKLER            |             |                        | MENDEZ, MANUEL A    |                  |
| 2372 S.E. BRISTOL, SUITE B   |             |                        | ART UNIT            | PAPER NUMBER     |
| NEWPORT BEACH, CA 92660-0755 |             |                        | 3763                |                  |
|                              |             |                        | MAIL DATE           | DELIVERY MODE    |
|                              |             |                        | 11/14/2007          | PAPER            |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/690,203             | KADZIAUSKAS ET AL.  |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Manuel Mendez          | 3763                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 November 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 12-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 12-36 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____.                                     |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                         |

## **DETAILED ACTION**

### **Response to Reconsideration Request**

The examiner of record has reviewed the request for reconsideration of the Official Action dated August 25, 2006. Since the Preliminary Amendment filed on November 4, 2005 cancelled claims 1-11, the Double patenting rejection of the cited Office Action is considered improper and is hereby vacated. Additionally, upon further review of pending claims 12-36, it is also found that a restriction requirement is necessary in view of the various related distinct inventions disclosed in the pending claims.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 12, 13, and 31, drawn to a system and method configured to **establish a correlation between a fluid flow through the eye, the phaco power and heat generation in the eye without measuring fluid temperatures**, classified in class 604, subclass 67.
- II. Claims 14-18, and 36, drawn to a system configured to **modulate at least one of a phaco power level, a phaco duty cycle, and the fluid flow through the eye, the modulation being based upon the energy balance**, classified in class 604, subclass 298.
- III. Claims 19-27, 32, and 33, drawn to **a matrix comprising phaco power levels and fluid flow conditions that will not generate sufficient heat**

**to create damage to the eye tissue within the eye, classified in class 604, subclass 294.**

IV. Claims 28, 29, 34, and 35, drawn to a **microprocessor configured to utilize a mathematical algorithm for determining an energy balance within the eye, and the microprocessor configured to determine whether to continue with existing power settings or switch to modified power settings**, classified in class 604, subclass 289.

V. Claims 30, drawn to a **look up table for determining an energy balance within the eye**, classified in class 604, subclass 65.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV and V are directed to distinct related inventions. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a **materially different design, mode of operation, function, or effect**; (2) the inventions **do not overlap in scope**, i.e., **are mutually exclusive**; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed comprise of manual and microprocessor-controlled systems having materially different modes of operations, which do not overlap in scope and are not obvious variants. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuel Mendez whose telephone number is 571-272-4962. The examiner can normally be reached on 0730-1800 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nicholas D. Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Manuel Mendez  
Primary Examiner  
Art Unit 3763

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